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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,897	01/17/2001	John J. Harrington	0221-00030(C)	3522

7590 01/14/2003
SHANKS & HERBERT
TransPotomac Plaza
1033 N. Fairfax St., Suite 306
Alexandria, VA 22314

EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 01/14/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,897

Applicant(s)

HARRINGTON ET AL.

Examiner

BJ Forman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Response to Amendments

This action is in response to papers filed 19 December 2002 in Paper No. 18 in which the specification was amended to add pages 53 and 54. The amendments have not been entered for the reasons stated below.

The instant application filed 17 January 2001 did not contain pages 53 and 54. The instant application was filed with a preliminary amendment. The amendment added a first sentence to the specification reciting "This is a continuation of application Serial No. 09/515,124 filed February 27, 2000." This amendment is a complete and independent statement. This amendment does not incorporate by reference the disclosure of the '124 application. It is noted that the following paragraph (previously the first paragraph) cross-references other parent applications which are incorporated by reference. However, the preliminary amendment is a complete statement independent from the following paragraph. It is noted that a supplemental amendment filed 27 March 2001 replaces the first paragraph of the specification to recite all cross-referenced applications in a single paragraph and to incorporate the disclosures of those applications by reference. However, the amendment was submitted after the filing date of 17 January 2001 and therefore was not part of the specification-as-filed.

Petitions Examiner Hearn and Applicant point to MPEP § 201.06(c) for guidance on the contents of a continuation application.

In a continuation or divisional application, the safeguard (petition and fee under former 37 CFR 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. **As a safeguard, however, an applicant may**

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incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. **The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation** or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

A priority claim under 35 U.S.C. 120 in a continuation or divisional application **does not amount to an incorporation by reference** of the application(s) to which priority is claimed.

For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement **must be included in the specification-as-filed**, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p).

The MPEP clearly states that the incorporation by reference of a parent application must be included in specification-as-filed and that a priority claim under 35 U.S.C. 120 does not amount to an incorporation by reference. The MPEP further states that the incorporation by reference statement permits applicant to amend the continuation application to add omitted portions of the specification.

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In the instant application, the incorporation by reference of the parent application was not included in the specification-as-filed. While the instant application was filed with a priority claim under 35 U.S.C. 120, the MPEP clearly states that a priority claim is not equivalent to an incorporation by reference. Because the specification-as-filed does not incorporate by reference the '124 application and because the MPEP clearly states that only the incorporation by reference of the parent application in the specification-as-filed permits amendments to include omitted portions of the specification, the amendments of Paper No. 18 will not be entered.

Applicant's comments regarding the criticality of the missing pages is not deemed relevant to the guidance provided by the MPEP which clearly states that only the incorporation by reference of the parent application in the specification-as-filed permits amendments to include omitted portions of the specification.

Conclusion

The examiner's Art Unit has changed from 1655 to 1634. Please address future correspondence to Art Unit 1634.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
Patent Examiner
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January 3, 2003